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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/603,011	06/25/2003	Keitaro Suzuki	239312US0 DIV	2431
22850	7590	05/09/2006		
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER METZMAIER, DANIEL S	
			ART UNIT 1712	PAPER NUMBER
DATE MAILED: 05/09/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/603,011

Applicant(s)

SUZUKI ET AL.

Examiner

Daniel S. Metzmaier

Art Unit

1712

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 01 May 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:
- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS


3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
- (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ They raise the issue of new matter (see NOTE below);
- (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.
- NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
- The status of the claim(s) is (or will be) as follows:
- Claim(s) allowed: _____.
- Claim(s) objected to: _____.
- Claim(s) rejected: 10-18.
- Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____
13. ☐ Other: _____.


Daniel S. Metzmaier
Primary Examiner
Art Unit: 1712

Continuation of 11. does NOT place the application in condition for allowance because: applicants' claims neither specifically define in any specific claim the nuclei materials or the coating materials. The claims do not set forth different materials for the nuclei and the coating materials or that the nuclei or coating materials are non-composites. Furthermore, the nuclei and the final particle size completely overlap.

Applicants (page 2) assert the examiner is ineffect testifying that acidic oxides are present without factual basis. This has not been deemed persuasive since the burden on the examiner is less regarding the establishment of a prima facie case of obviousness of a stated property in a product-by-process claim. "The Patent Office bears a lesser burden of proof in making out a case of prima facie obviousness for product-by-process claims because of their peculiar nature" than when a product is claimed in the conventional fashion. In re Fessmann, 489 F.2d 742, 744, 180 USPQ 324, 326 (CCPA 1974). See MPEP 2113. In the instant case, the claims are directed to a cured film on a substrate and not the coating composition, per se, that has been employed in the formation of said cured coating. The acidic oxide coating is an intermediate that has not been shown to be present in the final product as an acidic oxide.

Watabnabe employs the same ingredients reading on those broadly claimed. Furthermore, Watanabe discloses (column 3, lines 31-39) discloses coatings with antimony oxide sols as a curing agent with silanes and claimed. The claims read on the antimony oxide as the nuclei and the coating on the nuclei. Lastly, the tin oxide component would be expected to have related properties to the periodically adjacent antimony and would have surface oxides as a homogeneous composite.

Regarding applicants' assertions that the examiner has provided no basis or support the conclusions of acid groups in the particle surface, said presence would be implicit to an understanding of aqueous sol chemistry and the claims do not require completely coated particles. Furthermore, said surface acidic groups are immaterial to the "cured coating on a substrate" since there is no basis in the record that the acidic groups are still present in the cured coating or that said groups impart a patentably distinction of the cured coating on a substrate.

Applicants assert Nissan '784 discloses making zinc antimonate particles rather than coating nuclei with an acid oxide. Applicants further assert the Nissan '784 mixes colloidal antimony sols with a zinc compound to form said nuclei. This has not been deemed persuasive since (column 3, line 41) the antimony oxide may be in excess and (column 3, paragraph [0012]) the zinc compound may be zinc hydroxide or zinc oxide, which are insoluble in the system and would be expected to be colloidal.

In view of the breadth of the claimed subject matter and the claim form as product-by-process, the rejections are deemed proper and have been maintained.